

## Remarks and Arguments

1. Claims 1,2,7,8, and 13 through 15 have been provisionally rejected under the  
5 judicially created doctrine of obvious-type double patenting as being  
unpatentable over claims 1,2 and 9 through 11 of copending application No.  
10/023,494. The Office Action avers that the conflicting claims are not  
patentably distinct from each other even though they are not identical.  
Applicant cannot concur and respectfully submits that the claims in copending  
10 application No. 10/023,494 did not include limitations for a quick-release  
coupling and other features included in the present case. Applicant avers that  
these additional limitations are sufficiently distinct such that an obvious-type  
double patenting rejection does not apply to the instant matter. Applicant also  
avers that, at the time of the invention, all inventors were under a duty to  
15 assign their inventions to a common owner, namely Mr. William Milam.
2. Claims 1 – 3, 5 – 7 and 9 – 16 have been rejected under 35 USC 103(a) as  
being unpatentable over Lee (US Patent 6,147,797).

20 In order to support a *prima facie* case for obviousness using a particular set of  
references, the references must exhibit the following attributes:

- (a) The prior art references must collectively teach or suggest all of the  
claim limitations in the application;
- (b) There must be a reasonable expectation of success in modifying  
25 the reference; and
- (c) The references must suggest or provide some motivation to modify  
and / or combine the reference teachings.

The office action argues that Lee '797 discloses a lens mount (214 in Fig. 6).  
30 But this is simply not true. Upon a careful reading of Lee '797 (Col. 5, Lines

49 – 54), it is clear that reference numeral 214 in Fig. 6 is not a lens mount at all. Rather, reference 214 depicts what is called a “skirt”. It is also clear that the digital camera 200 pictured in Fig. 6 includes a lens 212. The lens 212 in Lee '767 comprises the operative lens which is used to focus an image onto the image plane provided by the digital camera 210. This operative lens cannot be removed. In the claimed method and apparatus, the camera, digital or otherwise, does not include a lens because the camera contemplated by the Applicant provides only a true lens mount. As such, the skirt 214 in Lee '767 is merely a convenient attachment for a quick-release coupling.

The office action also avers that Lee '797 teaches the use of a lens emulating flange opposing a coupling. This also is not true. In the claimed method and apparatus, a lens emulating flange (Page 16, Line 21 of Applicant's specification) is included in a camera adapter. This lens emulating flange mimics a standard camera lens, thereby allowing the attachment of a high quality camera, digital or otherwise, to the camera adapter. One distinction here is that the digital camera accepts the camera adapter as an ordinary camera lens. In Lee '797, a threaded element 224 is screwed into a corresponding thread included in the skirt 212 provided in the digital camera 210. Again, the lens 212 is fixed in the digital camera 210 introduced by Lee '797. Hence, any apparatus described by Lee '797 does not serve to emulate a camera lens as the office action avers. Again, this is only one and certainly not the only distinction because the quality of a lens provided by a fixed lens camera may not be suitable for high-quality optical examinations performed on a patient, as contemplated by applicant.

It is clear that the singular reference (i.e. Lee '797) provided by the office action fails to teach each every claim limitations set forth by the Applicant. as

such, the office action has failed to establish a prima facie case for obviousness.

5 Upon a further careful reading and study of Lee '797, there is absolutely no mention of emulating a camera lens as the Applicant here has taught. As such, the Applicant see absolutely no motivation whatsoever as to why an artisan would have been motivated by the teachings of Lee '797 to modify the reference teachings in a manner to yield an emulating mechanism as the applicant now claims as his own.

10 The burden of establishing obviousness carries with it an obligation to set forth a convincing line of reasoning as to why an artisan would have modified and/or combined the reference teachings. Simply stating that "it would have been obvious" is insufficient to meet this burden. The obviousness rejection  
15 set forth in the office action has not put forth any reasoning as to why the proposed modifications and combinations would be obvious.

3. With respect to all depended claims rejected by the office action, applicant submits that Claim 1 and Claim 9 have been demonstrated to be novel and  
20 non-obvious. As such, all dependent claims that stem from a non-obvious independent claim are to be considered as non-obvious.

4. With respect to Claim 5, the office action avers that the step of displacing an eyepiece as claimed by Applicant is notoriously well-known and the Examiner  
25 has taken Official Notice with respect to obviousness of this feature of the claimed method and apparatus. Applicant disagrees. In fact, applicant strongly disagrees. Applicant avers that taking official notice with respect to claim 5 is inappropriate because the Examiner has not met the required standard that official notice only be used where there can no refuting the  
30 assertion of obviousness. Applicant hereby demands that the Examiner

personally execute an affidavit of his personal knowledge or cite specific references that would lead one to the conclusion that displacement of an eyepiece is "notoriously well-known".

5 Also with respect to Claim 5, Applicant traverses the statement in the office action that displacement of an eyepiece included in an optical instrument so as to preclude interference with an eyepiece included in a camera is not patentable. This is feature is *very patentable*. Is not merely an intended use. In fact, considering Lee '797, the eyepiece of the microscope is no longer  
10 usable by a user. This is because the eyepiece of the microscope is completely dedicated to providing an optical image to the digital camera 210. In the claimed method and apparatus, the eyepiece of an optical instrument which is upgraded according to claimed method and apparatus may still viably be used by the user. Accordingly, Lee '797 actually teaches away from  
15 any continued use of the eyepiece. This is merely another feature that distinguishes the claimed method and apparatus from the prior art.

5. With respect to Claim 6, the Examiner again has taken official notice that displacement of the eyepiece is notoriously well-known and expected in the  
20 art. Again, in light of the fact that Lee '797 clearly demonstrates that the eyepiece is not usable other than as a means of providing optical imagery to the digital camera, the applicant vehemently disagrees that displacement of the eyepiece is notoriously well-known. Applicant avers that taking official notice with respect to claim 6 is inappropriate because the Examiner has not  
25 met the required standard that official notice only be used where there can no refuting the assertion of obviousness. Applicant hereby demands that the Examiner personally execute yet a second affidavit of his personal knowledge or cite other specific references that would lead one to the conclusion that displacement of an eyepiece is "notoriously well-known" with respect to  
30 Claim 6.

Also, Applicant avers that displacing the eyepiece is not merely an intended use as the office action avers. Displacement of the eyepiece to adjust interpupillary distance is not functionally equivalent to the claimed method and apparatus. Adjustment of interpupillary distance is provided in optical instruments for the purposes of accommodating users with varying width between their eyes. It has absolutely – repeat absolutely nothing to do with displacing the eyepiece for the purposes of non-interference with an eyepiece provided by a camera. A user of an upgraded apparatus will not use the original eyepiece provided by the upgraded apparatus and the eyepiece provided by the camera either simultaneously or in a stereoscopic manner. This same assertion must also be applied to the rejection of Claim 5.

6. With respect to Claim 7, Lee '797 does not teach an offset-eliminating flange as the office action purports. In fact, the Examiner's statement that an offset-eliminating flange is a flange that does not introduce an offset is absolutely ludicrous and contrary to the description provided by Applicant throughout the specification originally filed in this case. The offset-eliminating flange is not "an offset-eliminating flange because it does not create an offset" as the Examiner purports in the office action. In fact, applicant specifically states that offset-eliminating flange actively eliminates an offset introduced by other apparatus, one example of which is a parametric image generator (Last two paragraphs of Page 14). Applicant kindly requests that the Examiner carefully review the originally filed specification.

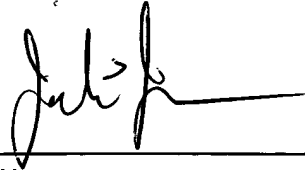
7. Claims 4 and 14 have been rejected under 35 USC 103(a) as being unpatentable over Lee '797 in view of Feinbloom (US Patent 4,413,278). Applicant first notes that Claims 1 and 14 stem from independent claims that have been demonstrated to be non-obvious. Accordingly, they cannot be adjudicated as obvious under 35 USC 103 (a). This is because Lee '797 fails

to teach each and every claim limitation to set forth by the Applicant and addition of Feinbloom does not remedy this deficiency.

8. Claim 8 has been rejected under 35 USC 103(a) as being unpatentable over Lee '797 in view of Applicants purported admissions. Applicant has made no admissions within the specification which can be used to sustain a rejection under 35 USC 103(a). In fact, the statement made in the office action that Applicant has admitted some prior art detrimental to Applicants position is simply false. Page 14, Lines 15 – 21 of Applicants specification makes no admissions with respect to the claimed method and apparatus. This portion of the specification merely points out one illustrative use case and nothing more.

9. Based on the foregoing, Applicant considers the present invention to be distinguished from the art of record. Accordingly, Applicant respectfully solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to Applicant, and the present application is therefore allowed to issue as a United States patent.

Respectfully submitted,



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